

ESTTA Tracking number: **ESTTA476131**Filing date: **06/04/2012**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91205093
Party	Defendant Paleteria La Michoacana, LLC
Correspondence Address	ROSEMARY S TARLTON MORRISON & FOERSTER LLP 425 MARKET STREET, 30TH FLOOR SAN FRANCISCO, CA 94105-2482 UNITED STATES
Submission	Answer and Counterclaim
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Signature	/Rosemary S. Tarlton/
Date	06/04/2012
Attachments	Answer to Opposition, Opp No. 91205093.pdf ( 11 pages )(437663 bytes )

## Registrations Subject to the filing

Registration No	2830401	Registration date	04/06/2004
Registrant	PRODUCTOS LACTEOS TOCUMBO, S.A. DE C.V. Luis Echeverria No. 156 Amp. Miguel Hidalgo Tlalpan, C.P. 14430, D.F. MEXICO		
Grounds for filing	The registered mark has been abandoned.		

## Goods/Services Subject to the filing

Class 030. First Use: 2001/04/20 First Use In Commerce: 2001/04/20 All goods and services in the class are requested, namely: ICE CREAM
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Registration No	3249113	Registration date	06/05/2007
Registrant	PRODUCTOS LACTEOS TOCUMBO, S.A. DE C.V. BENITO JUAREZ No. 37 SEGUNDA SECCION AMPLIACION DELEGACION TLALPAN MEXICO CITY, 14250 MEXICO		

## Goods/Services Subject to the filing

Class 016. First Use: 2001/04/20 First Use In Commerce: 2001/04/20 All goods and services in the class are requested, namely: Containers for ice made of paper or cardboard
Class 021. First Use: 2001/04/20 First Use In Commerce: 2001/04/20 All goods and services in the class are requested, namely: Drinking glasses
Class 025. First Use: 2001/04/20 First Use In Commerce: 2001/04/20 All goods and services in the class are requested, namely: Blouses; Camp shirts; Cap visors; Dress shirts; Hats; Headgear, namely, HATS, CAPS; Jackets; Jerseys; Pants; Polo shirts; Shirts; Short-sleeved or long-sleeved t-shirts; Shorts; Sport coats; Sport shirts; Suit coats; Sweat pants; Sweat shirts; Sweaters; T-shirts; Tank tops; Tops; Windshirts

Class 029. First Use: 2001/04/20 First Use In Commerce: 2001/04/20

All goods and services in the class are requested, namely: Frozen fruits; Fruit pulps; Milk; Milk based beverages containing fruit juice; Milk beverages containing fruits; Milk beverages with high milk content; Milk drinks containing fruits; Milk products excluding ice cream, ice milk and frozen yogurt

Class 032. First Use: 2001/04/20 First Use In Commerce: 2001/04/20

All goods and services in the class are requested, namely: Drinking water; Flavored waters; Flavoured waters; Frozen fruit beverages; Frozen fruit-based beverages; Fruit drinks; Fruit-flavored beverages

Class 035. First Use: 2001/04/20 First Use In Commerce: 2001/04/20

All goods and services in the class are requested, namely: Retail consignment stores in the field of ICE-CREAM AND FLAVOURED WATERS; Retail shops featuring ICE-CREAM AND FLAVOURED WATERS; Retail store services featuring a wide variety of consumer goods of others; Retail variety stores

Class 043. First Use: 2001/04/20 First Use In Commerce: 2001/04/20

All goods and services in the class are requested, namely: Serving food and drinks; Serving of food and drink/beverages

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

PRODUCTOS LACTEOS TOCUMBO, S.A. DE  
C.V.,

Opposer,

vs.

PALETERIA LA MICHOACANA, LLC,

Applicant.

Opposition No. 91205093

Application No.: 85/378,387

Mark: LA INDITA

**ANSWER TO NOTICE OF OPPOSITION**

Box TTAB FEE  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

Paleteria La Michoacana, LLC (“Applicant” or “PLM, LLC”) makes the following answers and statements to the Notice of Opposition filed by Productos Laceteos Tocumbo, S.A. de C.V. (“Opposer”):

1. Responding to Paragraph 1 of the Notice of Opposition, Applicant denies that Opposer is a leading retailer, dealer and distributor of ice cream and ice cream-related goods and services in the United States. Applicant lacks sufficient information or knowledge to form a belief as to the truth of the remaining allegations in Paragraph 1, and denies them on that basis.

2. Responding to Paragraph 2 of the Notice of Opposition, Applicant denies the allegations therein.

3. Responding to Paragraph 3 of the Notice of Opposition, Applicant denies that Opposer and/or its alleged licensees have continuously used the marks LA MICHOACANA, LA MICHAOCANA NATURAL and design, and an Indian girl design since at least as early as

February 8, 1995 in the United States. Applicant lacks sufficient information or knowledge to form a belief as to the truth of the remaining allegations in Paragraph 3, and denies them on that basis.

4. Responding to Paragraph 4 of the Notice of Opposition, Applicant denies that Opposer is the owner of Mexican Registration Nos. 500870, 852057, 781733 and 845194. Applicant lacks sufficient information or knowledge to form a belief as to the truth of the remaining allegations in Paragraph 4, and denies them on that basis.

5. Responding to Paragraph 5 of the Notice of Opposition, Applicant admits that the records of the Office for Harmonization in the Market (“OHIM”) identify Opposer as the owner of CTM Registration No. 003095403, registered on June 14, 2004. Applicant admits that the registration covers the goods and services alleged in Paragraph 5.

6. Responding to Paragraph 6 of the Notice of Opposition, Applicant denies that Opposer has used the LA FLOR DE MICHOACAN and LA FLOR DE MICHOACAN and design marks in United States interstate commerce in connection with “ice cream,” and further denies that Opposer has exercised sufficient control over any use of such marks by its alleged licensees. Applicant lacks sufficient information or knowledge to form a belief as to the truth of the remaining allegations in Paragraph 6, and denies them on that basis.

7. Responding to Paragraph 7 of the Notice of Opposition, Applicant admits that the records of the United States Patent and Trademark Office (“USPTO”) identify Opposer as the owner of the marks in Registration Nos. 2,830,401 and 3,249,113 for goods and services covered by the registrations, and further admits that a Section 15 affidavit was accepted by the USPTO for Registration No. 2,830,401. Applicant denies that Opposer has used the mark shown in Registration No. 3,249,113 in United States interstate commerce or that Opposer has exercised sufficient control over any use of such mark by its alleged licensees. Applicant lacks sufficient information and knowledge to form a belief as to the truth of the remaining allegations in Paragraph 7, and denies them on that basis.

8. Responding to Paragraph 8 of the Notice of Opposition, Applicant admits that the records of the USPTO indicate that Opposer filed Application Serial Nos. 78/771,243 and 78/954,490, and that those filings have been suspended pending the outcome of appeal of the Trademark Trial and Appeal Board (“TTAB”)’s decision in Cancellation Proceeding No. 92,047,438. Applicant denies the remaining allegations in Paragraph 8.

9. Responding to Paragraph 9 of the Notice of Opposition, Applicant admits that the records of the USPTO indicate that Opposer filed Application Serial Nos. 85/405,347 and 85/408,561, and that those applications have been published at the USPTO for the purposes of opposition.

10. Responding to Paragraph 10 of the Notice of Opposition, Applicant admits that its application to register the mark LA INDITA by Application Serial. No. 85/378,387 was filed on an intent-to-use basis and claims no date of first use. Applicant denies the remaining allegations in Paragraph 10.

11. Responding to Paragraph 11 of the Notice of Opposition, Applicant denies the allegations therein.

12. Responding to Paragraph 12 of the Notice of Opposition, Applicant denies that Opposer and/or its alleged licensees have continuously used and marketed any alleged “family” of trademarks since at least as early as April 2001 in the United States and before Applicant’s filing of its application to register the mark LA INDITA. Applicant lacks sufficient information or knowledge to form a belief as to the truth of the remaining allegations in Paragraph 12, and denies them on that basis.

13. Responding to Paragraph 13 of the Notice of Opposition, Applicant denies the allegations therein.

14. Responding to Paragraph 14 of the Notice of Opposition, Applicant denies that there is no issue as to priority of use. Applicant lacks sufficient information and knowledge of the dates of Opposer’s first use of each of its marks to form a belief as to the remaining allegations in Paragraph 14, and denies them on that basis.

15. Responding to Paragraph 15 of the Notice of Opposition, Applicant denies the allegations therein.

16. Responding to Paragraph 16 of the Notice of Opposition, Applicant admits that the LA INDITA mark shares the same prefix as each of Opposer's marks beginning with "LA." Applicant denies the remaining allegations in Paragraph 15.

17. Responding to Paragraph 17 of the Notice of Opposition, Applicant admits that it claims ownership of Registration No. 3,210,304 in Application 85/378,387. Applicant also admits that the TTAB ordered cancellation of Registration No. 3,210,304 on May 20, 2011, on the grounds that Opposer had established prior use of Opposer's Indian girl design, LA MICHOACANA mark, LA MICHOACANA NATURAL mark, and LA MICHOACANA NATURAL and design mark, and that the mark in Registration No. 3,210,304 gives rise to a likelihood of confusion with Opposer's Indian girl design, LA MICHOACANA mark, LA MICHOACANA NATURAL mark, and LA MICHOACANA NATURAL and design mark. Applicant lacks sufficient information or knowledge to form a belief as to the truth of the remaining allegations in Paragraph 17, and denies them on that basis.

18. Responding to Paragraph 18 of the Notice of Opposition, Applicant denies the allegations therein.

19. Responding to Paragraph 19 of the Notice of Opposition, Applicant admits that deposition testimonies were offered by Ignacio Gutierrez and Patricia Gutierrez in Cancellation Proceeding No. 92,047,438. Applicant denies the allegations of Paragraph 19 pertaining to these depositions to the extent that they are inconsistent with the publicly-available records of the testimonies. Applicant denies the remaining allegations in Paragraph 19.

20. Responding to Paragraph 20 of the Notice of Opposition, Applicant admits that it filed its application to register the LA INDITA mark with knowledge of the TTAB's decision to cancel the LA INDITA MICHOACANA and design mark shown in Registration No. 3,210,304 on the basis of Opposer's purported prior rights in and likelihood of confusion with the marks LA MICHOACANA, LA MICHOACANA NATURAL, LA MICHOACANA NATURAL and

design, and an Indian girl design. Applicant denies that the TTAB in that proceeding found any likelihood of confusion with Opposer's LA FLOR DE MICHOACAN and LA FLOR DE MICHOACAN and design marks.. Applicant admits that the LA INDITA MICHOACANA and design mark shown in Registration No. 3,210,304 contains the words LA INDITA, but denies that the TTAB found any similarity between the LA INDITA MICHOACANA and design mark and Opposer's marks on the basis of the LA INDITA words in Applicant's registered mark. Applicant lacks sufficient information or knowledge to form a belief as to the truth of the remaining allegations in Paragraph 20, and denies them on that basis.

21. Responding to Paragraph 21 of the Notice of Opposition, Applicant admits that Ignacio Gutierrez is president of PLM, LLC and that Ignacio Gutierrez signed the declaration associated with the LA INDITA mark as shown in the application herein opposed. Applicant denies the remaining allegations in Paragraph 21.

22. Responding to Paragraph 22 of the Notice of Opposition, Applicant denies the allegations therein.

23. Responding to Paragraph 23 of the Notice of Opposition, Applicant denies the allegations therein.

24. Responding to Paragraph 24 of the Notice of Opposition, Applicant denies the allegations therein.

25. Responding to Paragraph 25 of the Notice of Opposition, Applicant admits the allegations therein.

26. Responding to Paragraph 26 of the Notice of Opposition, Applicant denies the allegations therein.

27. Responding to Paragraph 27 of the Notice of Opposition, Applicant denies the allegations therein.

28. Responding to Paragraph 28 of the Notice of Opposition, Applicant denies the allegations therein.

29. Responding to Paragraph 29 of the Notice of Opposition, Applicant denies the allegations therein.

30. Responding to Paragraph 30 of the Notice of Opposition, Applicant denies the allegations therein.

31. Responding to Paragraph 31 of the Notice of Opposition, Applicant denies the allegations therein.

32. Responding to Paragraph 32 of the Notice of Opposition, Applicant denies the allegations therein.

33. Responding to Paragraph 33 of the Notice of Opposition, Applicant admits that it filed its application to register the LA INDITA mark with knowledge of the Board's decision to cancel the LA INDITA MICHOACANA and design mark shown in Registration No. 3,210,304 on the basis of Opposer's purported prior rights in and likelihood of confusion with the marks LA MICHOACANA, LA MICHOACANA NATURAL, LA MICHOACANA NATURAL and design, and an Indian girl design. Applicant denies that the TTAB in that proceeding found any likelihood of confusion with Opposer's LA FLOR DE MICHOACAN and LA FLOR DE MICHOACAN and design marks. Applicant denies the remaining allegations in Paragraph 33.

34. Responding to Paragraph 34 of the Notice of Opposition, Applicant denies the allegations therein.

35. Responding to Paragraph 35 of the Notice of Opposition, Applicant admits that registration of the LA INDITA mark will constitute prime facie evidence of Applicant's exclusive right to use the mark in commerce. Applicant denies the remaining allegations in Paragraph 35.

### **COUNTERCLAIM**

#### **(Cancellation of U.S. Registration No. 2,830,401)**

Applicant believes that it is damaged by Opposer's U.S. Registration No. 2,830,401 for the LA FLOR DE MICHOACAN mark because Opposer has asserted the mark against Application Serial. No. 85/378,387 and Applicant will be damaged by its continuing registration



if the TTAB finds a likelihood of confusion with the mark therein. Applicant hereby petitions to cancel the registration on the following grounds:

36. Applicant is informed and believes, and on that basis alleges, that Opposer has abandoned use of its LA FLOR DE MICHOACAN mark due to Opposer's failure to exercise sufficient control over any use of such mark by its alleged licensees and/or Opposer's failure to use the mark for at least three consecutive years with no intent to resume use prior to the filing of this counterclaim.

37. Applicant is informed and believes, and on that basis alleges, that Opposer's LA FLOR DE MICHOACAN mark does not function as a trademark due to widespread uncontrolled use by third parties and is therefore abandoned.

### **COUNTERCLAIM**

#### **(Cancellation of U.S. Registration No. 3,249,113)**

Applicant believes that it is damaged by Opposer's U.S. Registration No. 3,249,113 for the LA FLOR DE MICHOACAN and design mark because Opposer has asserted the mark against Application Serial. No. 85/378,387 and Applicant will be damaged by its continuing registration if the TTAB finds a likelihood of confusion with the mark therein. Applicant hereby petitions to cancel the registration on the following grounds:

38. Applicant is informed and believes, and on that basis alleges, that Opposer has abandoned use of its LA FLOR DE MICHOACAN and design mark due to Opposer's failure to exercise sufficient control over any use of such mark by its alleged licensees and/or Opposer's failure to use the mark for at least three consecutive years with no intent to resume use prior to the filing of this counterclaim.

39. Since at least as early as 1991, Applicant and its predecessors have continuously used the MICHOACANA term in trademarks and trade names, including but not limited to "Paleteria Michoacana," "Paleteria La Michoacana," "La Michoacana," and "La Michoacana Es Natural," in connection with ice cream and ice cream-related products in the United States. Applicant's first

use of marks including the term MICHOCACANA is substantially prior to Opposer's filing of its application to register the LA FLOR DE MICHOCACAN and design mark.

40. Applicant does not believe that there is likelihood of confusion between its LA INDITA mark and Opposer's LA FLOR DE MICHOCACAN and design mark, but should the TTAB find a likelihood of confusion in the above-captioned proceeding, Applicant is entitled to cancellation of the LA FLOR DE MICHOCACAN and design mark due to Applicant's prior use of MICHOCACANA-based marks identified in Paragraph 39 above.

41. Applicant is informed and believes, and on that basis alleges, that Opposer's LA FLOR DE MICHOCACAN and design mark does not function as a trademark due to widespread uncontrolled use by third parties and is therefore abandoned.

42. Applicant is informed and believes, and on that basis alleges, that Opposer has not made bona fide use of the LA FLOR DE MICHOCACAN and design mark in commerce in connection with all goods and services identified in the corresponding application, including but not limited to paper or cardboard containers for ice in International Class 16, drinking glasses in International Class 21, clothing and headgear in International Class 25, frozen fruits and milk products (excluding ice cream) in International Class 29, water and fruit-flavored beverages in International Class 32, and retail consignment stores relating to ice cream and flavored waters, retail store services featuring a wide variety of consumer goods of others, and retail variety stores in International Class 35, prior to the application's filing date on December 8, 2005.

#### **AFFIRMATIVE DEFENSES**

Upon information and belief, Applicant alleges as follows:

43. The Notice of Opposition fails to state a claim upon which relief may be granted to Opposer.

44. Opposer's request for relief is barred by the doctrine of unclean hands.

45. Opposer's request for relief is barred by Applicant and its predecessors' prior use of the MICHOCACANA term in trademarks and trade names in connection with ice cream and ice cream-related products since as early as 1991 in the United States.

46. Opposer's request for relief is barred by Applicant and its predecessors' prior use of the Indian girl design shown in Opposer's Application Serial No. 78/771,243.

47. Opposer's request for relief is barred by the descriptive nature of the MICHOACANA term when used in connection with ice cream and ice cream-related products.

48. The marks LA MICHOACANA, LA MICHOACANA NATURAL, LA MICHAOCANA NATURAL and design, LA FLOR DE MICHOACAN, LA FLOR DE MICHOACAN and design, and Indian girl design have been abandoned by Opposer and/or its alleged licensees due to Opposer's failure to exercise sufficient control over any use of such mark by its alleged licensees and/or the failure of Opposer or its licensees to use such marks.

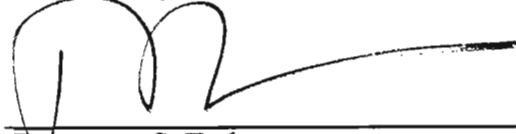
49. Opposer's marks LA MICHOACANA, LA MICHOACANA NATURAL, LA MICHAOCANA NATURAL and design, LA FLOR DE MICHOACAN, LA FLOR DE MICHOACAN and design fail to function as trademarks due to widespread uncontrolled use by third parties and are therefore abandoned.

WHEREFORE, Applicant prays:

1. That Opposer's Notice of Opposition be dismissed with prejudice;
2. That registration of the mark in Application Serial No. 85/378,387 be allowed;
3. That Opposer's Registration Nos. 2,830,401 and 3,249,113 be cancelled; and
4. That any such further relief be granted to Applicant as deemed appropriate.

The Commissioner is hereby authorized to charge any fees which may be required to Deposit Account No. 03-1952.

Respectfully submitted,



Dated: June 4, 2012

By:

Rosemary S. Tarlton  
Attorney for Applicant  
Paleteria La Michoacana, LLC

Morrison & Foerster LLP  
425 Market Street  
San Francisco, California 94105-2482  
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Facsimile: (415) 268-7522

### **PROOF OF SERVICE BY MAIL**

I am employed with the law firm of Morrison & Foerster LLP, whose address is 425 Market Street, San Francisco, California, 94105; I am not a party to the within cause; I am over the age of eighteen years and I am readily familiar with Morrison & Foerster's practice for collection and processing of correspondence for mailing with the United States Postal Service and know that in the ordinary course of Morrison & Foerster's business practice the document described below will be deposited with the United States Postal Service on the same date that it is placed at Morrison & Foerster with postage thereon fully prepaid for collection and mailing.

I further declare that on June 4, 2012, I served copies of:

### **ANSWER TO NOTICE OF OPPOSITION**

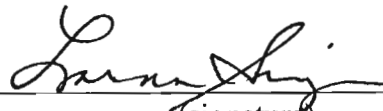
on the following by placing a true copy thereof enclosed in a sealed envelope addressed as follows for collection and mailing at Morrison & Foerster LLP, 425 Market Street, San Francisco, California, 94105, in accordance with Morrison & Foerster's ordinary business practices:

Stephen L. Anderson  
Anderson & Associates  
27247 Madison Avenue, Suite 120  
Temecula, CA 92590

I declare under penalty of perjury under the laws of the State of California that the above is true and correct.

Executed at San Francisco, California, this 4<sup>TH</sup> day of June, 2012.

\_\_\_\_\_  
Lorna Simpson  
(typed)

\_\_\_\_\_  
  
(signature)

Opposition No. 91205093